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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,839

06/27/2005

Masanori Abe

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EXAMINER

MILLER, DANIEL H

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,839	Applicant(s) ABE ET AL.	
	Examiner DANIEL MILLER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/1/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7, 11-19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7, 11-19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2008 has been entered.

Claim Rejections - 35 USC § 102/103

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 3-4, 7, 14-15, 18-19 and 22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Young (6,586,087).
2. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52,-190 USPQ 461,463 (CCPA 1976). "Absent a clear indication in the specification or claims of what the basic and

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novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

3. Young teaches an article of manufacture that has a component (substrate) capable of being sealed with a copper aluminosilicate glass. The glass has a composition consisting essentially, in terms of weight percent on an oxide basis, of 35-68 SiO₂, 3-25 Al₂O₃, 2-26 B₂O₃, 0-20 R₂O, 0-30 RO, 2-33 CuO, 0-4 F, 0-10 M_xO_y, where R₂O is an alkali oxide selected from the group consisting of Li₂O, Na₂O, and K₂O, and RO is an alkaline earth oxide selected from the group consisting of CaO, MgO, ZnO, SrO, and BaO, and M_xO_y is a transition metal oxide selected from the group consisting of Co₂O₃, TiO₂, NiO, MnO₂, and Fe₂O₃. The present invention also pertains to a method of sealing the article (see abstract).
4. The compositional percentages taught overlaps applicant's claimed compositions, therefore the disclosure is considered to anticipate the reference. In the alternative, it would have been obvious to select a composition within the range as disclosed by applicant and taught by the reference (Young) since they overlap compositionally and percentage wise.
5. Regarding applicant's claimed to spherical protruded layers and zirconium and group 3a concentration, it appears from applicant's disclosure that the layers are formed inherently from the composition. Therefore, the same layering and protrusions as claimed by applicant would be expected in the disclosed invention of Young.

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6. Claims 3-4, 7, 14-15, 18-19 and 22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chiba (6,362,119).

7. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52,-190 USPQ 461,463 (CCPA 1976). "Absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

8. Chiba teaches a barium borosilicate glass which consists essentially of, as represented by mass% based on the following oxides:

9. B.sub.2 O.sub.3 5 to 35%, SiO.sub.2 0.5 to 30%, BaO 25 to 75%, Al.sub.2 O.sub.3 0.5 to 13%, SnO.sub.2 0 to 2%, CeO.sub.2 0 to 2%, MgO + CaO + SrO 0 to 10%, ZnO 0 to 20%, TiO.sub.2 0 to 5%, ZrO.sub.2 0 to 5%, Li.sub.2 O 0 to 5%, Na.sub.2 O 0 to 5%, and K.sub.2 O 0 to 5% (see abstract).

10. The compositional percentages taught overlaps applicant's claimed compositions, therefore the disclosure is considered to anticipate the reference. In the alternative, it would have been obvious to select a composition within the range as disclosed by applicant and taught by the reference since they overlap compositionally and percentage wise.

11. The glass is used on a coating in a variety of application (substrates), such as glaze for dishes or coatings for electronic components (column 1 line 5-10).

12. Regarding applicant's claimed to spherical protruded layers and zirconium and group 3a concentration, it appears from applicant's disclosure that the layers are formed inherently from

the composition. Therefore, the same layering and protrusions as claimed by applicant would be expected in the disclosed invention of Chiba.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5-6, 11-13, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiba (US 6,362,119) in view of Kub (US 6,323,108).

15. Chiba teaches a barium borosilicate glass which consists essentially of, as represented by mass% based on the following oxides:

B.sub.2 O.sub.3 5 to 35%, SiO.sub.2 0.5 to 30%, BaO 25 to 75%, Al.sub.2 O.sub.3 0.5 to 13%, SnO.sub.2 0 to 2%, CeO.sub.2 0 to 2%, MgO + CaO + SrO 0 to 10%, ZnO 0 to 20%, TiO.sub.2 0 to 5%, ZrO.sub.2 0 to 5%, Li.sub.2 O 0 to 5%, Na.sub.2 O 0 to 5%, and K.sub.2 O 0 to 5% (see abstract).

16. The compositional percentages taught overlaps applicant's claimed compositions, therefore the disclosure is considered to anticipate the reference in this regard. In the alternative, it would have been obvious to select a composition within the range as disclosed by applicant and taught by the reference since they overlap compositionally and percentage wise.

17. The glass is used on a coating in a variety of applications (substrates), such as glaze for dishes or coatings for electronic components (column 1 line 5-10).
18. However the reference is silent as to an intermediate SiO₂ layer.
19. Kub teaches a common configuration for an electrical device (semiconductor) with a silicon substrate and a SiO₂ interlayer (see figures). It would have been obvious to use the sealing layer of Chiba in the electrical device of Kub providing a SiO₂ interlayer because it is a common and known electrical (semiconductor) configuration and the coatings of Chiba are taught to be employed for electrical devices.
20. The claimed molten layer would inherently form when the melted top layer of Chiba is formed over the SiO₂ layer of Kub.

Response to Arguments

21. Applicant's arguments filed 10/1/2008 have been fully considered but they are not persuasive.
22. Applicant is reminded that the claim language "consisting essentially of" is interpreted as "comprising". Applicant has made no showing that the included material affects the basic and novel characteristics of the invention. Therefore, the claim language is properly interpreted as "comprising" (see below). The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52,-190 USPQ 461,463 (CCPA 1976). "Absent a clear indication in the specification or claims of what the basic

and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

23. Regarding the 103 rejection, Kub teaches a common configuration for an electrical device (semiconductor) with a silicon substrate and a SiO₂ interlayer (see figures). It would have been obvious to use the sealing layer of Chiba in the electrical device of Kub providing a SiO₂ interlayer because it is a common and known electrical (semiconductor) configuration and the coating of Chiba are taught to be employed for electrical devices.

24. Applicant has further argued the intended use of the claimed invention, while pointing to the instant specification. The intended use of the invention does not patentably distinguish the claims. Further, these arguments are non commensurate in scope with the claimed invention. Similarly applicant's arguments with regards to diffusion of copper and softening points are also non commensurate in scope with the claim.

25. It is noted that applicant has not claimed a softening point or an operating temperature.

26. Applicant should incorporate the argued limitations into the claims if applicant intends for those features to be given greater patentable weight, so long as those limitations are supported by the originally-filed specification.

27. The Davis reference can not be fully considered until applicant actually submits the non patent literature and present a fully developed argument.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL MILLER whose telephone number is (571)272-1534. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571)272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel Miller

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794